DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/27/08

has been entered.

Response to Amendment

The amendment of 3/27/08 has been entered. Claims 1-30 are pending and

rejected as followed.

Claims Status

As of 3/27/08, claims 1-30 are pending. There are 3 method claims: 10-15, 16-

23, and 24-30 with 1 system claim 1-9 which is basically the system to carry out the first

method claim 10-15. Claim 10 appears to be the broadest method claim and will be

addressed first.

As of 3/27/08, independent method claim 10 is as followed:

10. (currently amended) A method for measuring usage at least one asset

class over a network with a plurality of instant capacity on demand (iCOD) computers

comprising:

(a) receiving data about a quantity of assets of the at least one asset class for

each iCOD computers on the network,

(b) summing the quantity of assets of the at least one asset class for all of the

plurality of iCOD computers on the network, thereby obtaining a sum of assets for the

at least one asset class;

(c) providing a notification if the sum of assets differs from a previously

specified total for the assets for the at least one asset class, and allowing payment-free

transfer of assets from one iCOD computer to another iCOD computer within the

network.

Note: for convenience, alphabetical letters (a) – (c) are added to the beginning of

each step.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or
composition of matter, or any new and useful improvement thereof, may obtain a patent therefor,
subject to the conditions and requirements of this title.

2.   Claims 10-15, 16-23 and 24-30 are rejected under 35 U.S.C. 101 based on

Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to

examiners is that a § 101 process must (1) be tied to another statutory class (such as a

particular apparatus) or (2) transform underlying subject matter (such as an article or

materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981);

Parker v. Flook, 437 U.S. 584,588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70

(1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). These method claims do not

exhibit transformation in the body of the claim nor are they tied to another statutory

class such as using or implemented by a computer. They appear to be mental steps for

issues related to iCOD computer on the network.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating
        obviousness or nonobviousness.

5.   **Claims 10-15, 16-23, 1-9, 24-30 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over (1) AAPA (applicant admitted prior art) in view of (2) PROIETTI.

In summary, **independent method[1] claim 10** deals with a method for measuring

at least one monitored asset (computer component) belonging to at least one asset

class over a network with a plurality of computers (cluster) comprising:

(a) receiving a data about quantity of assets (components) at the at least one

asset class (CPU or storage) for each computer on the network, wherein each iCOD

computer is an independently licensed system;

(b) summing (totalizing) the quantity of assets (components) of the at least one asset

class for all of the plurality of iCOD computers on the network, thereby forming a

sum of assets data, and

(c.) providing a notification (reminder) if the sum of assets data differs from a

previously specified total data for the assets for the at least one asset class, wherein the

assets may be either inactive or active, <u>thereby allowing payment-free transfer of active</u>

<u>assets from one iCOD computer to another iCOD computer within the network.</u>

Note that the last step with the phrase "assets <u>may be</u> either inactive or active,

thereby …. Within the network". The term "maybe" is considered as being optional

since it reads over "is" or "is not", and therefore whatever limitations followed this

"optional" limitation is considered as non-patentable weight since this is optional and not

required. Moreover, what happens if the assets are "<u>inactive</u>"? Is there still a payment-

free transfer of active assets from one <u>iCOD computer to another iCOD computer within</u>

<u>the network?</u>

Similarly, **AAPA**, as shown in the "Background" of pages 1-2, fairly discloses a

method for measuring at least one monitored asset (computer component, i.e. CPU)

belonging to at least one (or 1) asset class (CPU) over a network with a plurality of

computers (cluster) comprising:

(a) receiving a data about an asset (computer components, i.e. CPU) at the at

least one asset class (CPU or storage) for each computer on the network,

(b) summing the quantity of asset (computer components, CPUs) of the at least

one asset class for each iCOD system (computer) individually on the network, thereby

forming a sum of assets data, and

{see page 1, lines 15-27}

(c.) providing a notification (reminder) if the sum of assets data differs from a

previously specified total data for the assets for the at least one asset class, wherein the

assets may be either inactive or active.

{see page 1, 2nd paragraph or lines 22-27}.

Therefore, it appears that AAPA teaches the claimed invention <u>except for :</u>

(1) <u>thereby allowing payment-free transfer of active assets from one iCOD</u>

<u>computer to another iCOD computer within the network.</u>

This is agreed upon by the applicant on the applicant's amendment of 9/26/06.

PROIETTI teaches a method for managing/monitoring/controlling integrated

services to minimize the high recurring equipment subscription service costs for each

equipment when applied to group of equipments or collective operations of equipments

by <u>managing/controlling</u> and <u>sharing</u> <u>a limited number</u> of equipment subscription

services (i.e. 2 subscription services) among a group of equipments (i.e. 3-5

equipments) by remote programming so that transfer of active asset/equipment usage

upon activation is payment free since the service is limited to within the desired

subscribed service and as the other equipment is deactivated {see col. 1, lines 20-67,

col. 2, lines 1-32, and cols. 3-4 and 8, Figs. 1, 2 and 4}. It would have been obvious to

modify the teachings of AAPA, step c) by managing/controlling and <u>sharing</u> <u>a limited</u>

number of equipment subscription services (i.e. 2 subscription services) among a group

of equipments (i.e. 3-5 equipments) by remote programming as taught by PROIETTI so

that transfer of active asset/equipment usage upon activation is payment free since the

service is limited to within the desired subscribed service and as the other equipment is

deactivated, thus minimizing the high recurring equipment subscription service costs for

each equipment when applied to group of equipments or collective operations of

equipments.

     As for dep. claim 11 (part of <u>10</u> above), which deals with well known audit

reporting parameters/features, i.e. decrypting data due to sensitive data for personal or

security reason, this is non-essential to the claimed invention and is well known and/or

inherently included in AAPA or PROIETTI or would have been obvious to do so for

security/personal reason.

     As for dep. claims 12-13 (part of <u>10</u> above), which deals with well known

licensing auditing (iCOD / licensing) parameters, i.e. comparing actual/reported data to

expected data for monitoring usage, these are well known and inherently included in

AAPA {see page 1, 2nd full paragraph}.

     As for dep. claims 14-15 (part of <u>10</u> above), which deals with well known

licensing auditing (iCOD) parameters, i.e. issuing a payment or an invoice from the

system vendor, these are well known parameters and are taught in AAPA page 1, 2nd

paragraph.

     As for independent <u>system</u>[1] claim <u>1</u>, which is the system to carry out

independent method claim 10 above, it's rejected over the system of AAPA /PROIETTI

to carry out the method claim 1 as cited above. Moreover, it would have been obvious
to a skilled artisan to set up the proper system to carry out the method steps as shown
in claim 10 above.

   As for dep. claims 2-5 (part of <u>1</u> above), which have the same limitations as in
dep. claims 11-15 respectively, they are rejected for the same reasons set forth in dep.
claims 11-15 above.

   As for dep. claims 6-9 (part of <u>1</u> above), which deals with well known iCOD
parameters, i.e. CPU, hard disk capacity, memory (storage), or I/O ports, etc., these are
taught in AAPA.

   As for independent <u>method</u>[2] claim <u>16</u>, which explicitly differs from independent
method claim 10 at the 1st step "receiving data about", however, the result of the 1st and
2nd steps of claim 16, "measuring a quantity" and "transmitting the data about the
quantity" producing the same result as in the 1st step of claim 10 above. Therefore, the
1st and 2nd steps of claim 10 are inherently included in the teachings of AAPA, page 1,
2nd paragraph.

   As for dep. claims 17-18 (part of <u>16</u> above), which deals with well known
licensing auditing (iCOD) parameters, i.e. measuring a quantity of inactive/active
component, these are well known parameters and are taught in AAPA page 1, 2nd
paragraph.

   As for dep. claims 19-23 (part of <u>16</u> above), which have the same limitations as
in dep. claims 11-15 respectively, they are rejected for the same reasons set forth in
dep. claims 11-15 above.

As for independent **method**[3] **claim 24**, which differs from independent method claim 10 at the 1st step "grouping the computers into at least one cluster", or "grouping", this concept is fairly taught in PROIETTI.

As for **dep. claim 25** (part of 10 above), which deals with well known audit reporting parameters of a clusters of network computers, i.e. registering the computers into the cluster, this is non-essential to the claimed invention and is inherently included in AAPA or PROIETTI or would have been obvious to do so for keeping track of the computers in a cluster.

As for **dep. claims 26-30** (part of 24 above), which have the same limitations as in dep. claims 11-15 respectively, they are rejected for the same reasons set forth in dep. claims 11-15 above.

6.　　Claims 10-15, 16-23, 1-9, 24-30 are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over (1) AAPA (applicant admitted prior art) in view of (2) ARTICLE 11/1999 and 3) PROIETTI.

The teaching of AAPA is cited above.

In a similar iCOD environment, **ARTICLE 11/1999** discloses future on-demand programs which will include other server (CPU) components, such as (1) memory and (2) input/output (I/O), (3) storage sub-systems and (4) HP's HyperPlex clusters to meet demands of customers whose livelihoods depend on delivering high levels of capacity, performance and availability for Internet-based applications and "pay as you go" infrastructure program which allows dynamic response to ever-changing business demands which is sensible and beneficial (economical) to the server and storage

customers {see page 1, paragraphs 2, 4, 5 and 6, page 2, 1st and 2nd}. ARTICLE 1999

also teaches the concept of providing iCOD solution for HP 9000 Enterprise Server**s**

and when customers' needs change and they need more processing power, they can

instantly activate the needed processors with a simple HP-UX command and there will

be <u>no charge for activation</u> {see page 1, paragraphs 4, 5 and page 2, paragraph 2}.

 It would have been obvious to modify the "on-demand" or "pay as you go"

program/method of AAPA by adjusting the summing or sum of assets to include other

computer (CPU/server) components, such as (1) memory and (2) input/output (I/O), (3)

storage sub-systems or (4) HP's HyperPlex **clusters**, in steps (a)-(c.) and on plurality of

computers/servers (cluster or group) as taught by ARTICLE 11/1999 for one of the

benefits cited above such as dynamic response, pay as you go, or sensible and

beneficial (economical) to meet the consumer's demands for speed, content,

availability, cost, etc. of internet-based applications which depend on those 4 variables

cited above. Again, ARTICLE 1999 fairly teaches the users can instantly activate the

needed processor<u>s</u> with a command and no charge for activation, which indicate that

the account/contract contains a plurality of iCOD computers (processors) or the

provided clusters contain a plurality of iCOD computers (processors or servers). As for

the amended limitation of the last step, this is inherently included or taught in view of the

teachings of ARTICLE 11/1999 in view of AAPA in view of the teachings of "no charge

for activation" as cited in above.   Moreover, putting more than one computer on the

service contract or account would have been obvious as mere duplicating service/parts

for multiple effects on the same account if desired. See In re Harza, 124 USPQ 378,

380 (CCPA 1960).

AAPA/ARTICLE 11/1999 teaches the claimed invention <u>except for</u>:

(1) the resultant step of (c) of "thereby allowing payment-free transfer of active

assets from one iCOD computer to another iCOD computer within the network".

PROIETTI teaches a method for managing/monitoring/controlling integrated

services to minimize the high recurring equipment subscription service costs for each

equipment when applied to group of equipments or collective operations of equipments

by <u>managing/controlling</u> and <u>sharing</u> <u>a limited number</u> of equipment subscription

services (i.e. 2 subscription services) among a group of equipments (i.e. 3-5

equipments) by remote programming so that transfer of active asset/equipment usage

upon activation is payment free since the service is limited to within the desired

subscribed service and as the other equipment is deactivated {see col. 1, lines 20-67,

col. 2, lines 1-32, and cols. 3-4 and 8, Figs. 1, 2 and 4}. It would have been obvious to

modify the teachings of AAPA/ARTICLE 11/1999 of step c) by managing/controlling and

<u>sharing</u> <u>a limited number</u> of equipment subscription services (i.e. 2 subscription

services) among a group of equipments (i.e. 3-5 equipments) by remote programming

as taught by PROIETTI so that transfer of active asset/equipment usage upon activation

is payment free since the service is limited to within the desired subscribed service and

as the other equipment is deactivated, thus minimizing the high recurring equipment

subscription service costs for each equipment when applied to group of equipments or

collective operations of equipments.

   As for dep. claim 11 (part of <u>10</u> above), which deals with well known audit
reporting parameters/features, i.e. decrypting data due to sensitive data for personal or
security reason, this is non-essential to the claimed invention and is well known and/or
inherently included in AAPA or ARTICLE 11/1999 or PROIETTI or would have been
obvious to do so for security/personal reason.

   As for dep. claims 12-13 (part of <u>10</u> above), which deals with well known
licensing auditing (iCOD / licensing) parameters, i.e. comparing actual/reported data to
expected data for monitoring usage, these are well known and inherently included in
AAPA {see page 1, 2nd full paragraph}.

   As for dep. claims 14-15 (part of <u>10</u> above), which deals with well known
licensing auditing (iCOD) parameters, i.e. issuing a payment or an invoice from the
system vendor, these are well known parameters and are taught in AAPA page 1, 2nd
paragraph.

   As for independent <u>system</u>[1] claim <u>1</u>, which is the system to carry out
independent method claim 10 above, it's rejected over the system of AAPA /ARTICLE
11/1999/PROIETTI to carry out the method claim 1 as cited above. Moreover, it would
have been obvious to a skilled artisan to set up the proper system to carry out the
method steps as shown in claim 10 above.

   As for dep. claims 2-5 (part of <u>1</u> above), which have the same limitations as in
dep. claims 11-15 respectively, they are rejected for the same reasons set forth in dep.
claims 11-15 above.

As for **dep. claims 6-9** (part of 1 above), which deals with well known iCOD parameters, i.e. CPU, hard disk capacity, memory (storage), or I/O ports, etc., these are taught in ARTICLE 11/1999 page 1, 5th paragraph.

As for independent **method**[2] **claim 16**, which explicitly differs from independent method claim 10 at the 1st step "receiving data about", however, the result of the 1st and 2nd steps of claim 16, "measuring a quantity" and "transmitting the data about the quantity" producing the same result as in the 1st step of claim 10 above. Therefore, the 1st and 2nd steps of claim 10 are inherently included in the teachings of AAPA, page 1, 2nd paragraph.

As for **dep. claims 17-18** (part of 16 above), which deals with well known licensing auditing (iCOD) parameters, i.e. measuring a quantity of inactive/active component, these are well known parameters and are taught in AAPA page 1, 2nd paragraph.

As for **dep. claims 19-23** (part of 16 above), which have the same limitations as in dep. claims 11-15 respectively, they are rejected for the same reasons set forth in dep. claims 11-15 above.

As for independent **method**[3] **claim 24**, which differs from independent method claim 10 at the 1st step "grouping the computers into at least one cluster", however, this step is fairly taught in ARTICLE 11/1999 as one of the new iCOD option, HP's HyperPlex clusters, and is therefore inherently included in the teachings of AAPA / ARTICLE 11/1999/PROIETTI.

As for dep. claim 25 (part of <u>10</u> above), which deals with well known audit reporting parameters of a clusters of network computers, i.e. registering the computers into the cluster, this is non-essential to the claimed invention and is inherently included in AAPA or ARTICLE 11/1999 or would have been obvious to do so for keeping track of the computers in a cluster.

As for dep. claims 26-30 (part of <u>24</u> above), which have the same limitations as in dep. claims 11-15 respectively, they are rejected for the same reasons set forth in dep. claims 11-15 above.

Response to Arguments

7.   Applicant's arguments filed 3/27/08 have been fully considered but they are not persuasive. Applicant's comment that the combination of the AAPA in view of PROIETTI does not teach or suggest step (b) of "summing the quantity of assets of the at least one asset *class for all of the plurality of iCOD computers on the network,*" as recited in claim 10 (emphasis added). Neither PROIETTI nor the AAPA sum assets for all of the plurality of iCOD computers on a network. "The current iCOD pricing system also treats each iCOD system individually for purposes of auditing the CPU totals." (see Background, p. 1, para. [0005]). These are not found persuasive, because page 1, lines 15-22 discloses that the audit report will typically show the CPUs that are inactive and the total number of CPUs. Clearly, this talks about the total number of CPUs.

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Current iCOD systems send an iCOD audit report to an auditing system belonging
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to the iCOD system vendor. The iCOD audit report will typically show the CPUs that are

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inactive and the total number of CPUs. Inactive capacity is measured because the iCOD
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customer is free to add non-iCOD CPUs, but is not permitted to activate inactive iCOD
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CPUs without paying additional licensing fees. An expected number of inactive CPUs
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corresponds to the iCOD CPUs that the customer owns but has not paid to activate, and a
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comparison is made between the reported totals of inactive CPUs and the expected totals
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of inactive CPUs. A reminder or bill may be issued if the iCOD reports show less
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inactive CPU capacity than that which was originally expected, as any reduction in
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inactive CPU capacity implies additional CPUs have been activated without being paid
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for. The iCOD pricing system thus permits the iCOD customer to pay for the processing
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power that the customer is actually using on a given system but also gives the iCOD
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customer the ability to easily expand the customer's system should needs change.

As for the comment of "The current iCOD pricing system also treats each iCOD system individually for purposes of auditing the CPU totals.", this is noted, but not found persuasive because this appears to deal with "pricing" issue and not "auditing report" and moreover, the background of the invention or AAPA can have many embodiments or teachings in which the selection of 1 embodiment is proper to indicate the AAPA teaching.

8.   Note also that claims 10-15, 16-23, 1-9, 24-30 are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over (1) AAPA (applicant admitted prior art) in view of (2) ARTICLE 11/1999 and (3) PROIETTI and applicant has not rebutted this rejection..

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. US 2003/0079092, section [0006] discloses the benefit of iCOD

for storage disk which is high cost for capital, operating expenses for power, raised floor

spaces, heat, no return on assets or investments (ROA or ROI) on unused storage disk.

       No claims are allowed.

10.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see http://pair-direct@uspto.gov. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

        In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov .

        Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

        Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.
        The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689

June 22, 2008